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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,942	12/12/2003	Tomomi Oshiba	KOT-0008-C	5721
23413	7590	09/01/2006	EXAMINER	
CANTOR COLBURN, LLP			DOTE, JANIS L	
55 GRIFFIN ROAD SOUTH			ART UNIT	
BLOOMFIELD, CT 06002			PAPER NUMBER	

1756

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/734,942

Applicant(s)

OSHIBA ET AL.

Examiner

Janis L. Dote

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5 and 8-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/505,459.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 1756

1. This is a continuation of copending US application serial no. 09/505,459, filed on Feb. 11, 2000, which is now abandoned.

2. The examiner acknowledges the amendments to claims 1, 5, and 11, the cancellation of claims 6 and 7, and the addition of claims 12-19 set forth in the preliminary amendment filed on Aug. 11, 2006. Claims 1-5 and 8-19 are pending.

The examiner notes that the "Amendment to the specification" section filed on Aug. 11, 2006, has been entered.

3. The "Amendment to the specification" section and the "Amendment to the claims" section filed in the preliminary amendment on Feb. 25, 2005, did not comply with 37 CFR 1.121 for the reasons set forth in the Notice of non-compliant amendment mailed on Jul. 12, 2006. Said "Amendment to the specification" section and "Amendment to the claims" section have not been entered.

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5 and 8-17, drawn to toners (Ia) and image forming methods (Ib), classified in class 430,

Art Unit: 1756

subclass 108.4, and class 430, subclass 120,
respectively.

II. Claim 18, drawn to a method of making toners,
classified in class 430, subclass 137.18.

III. Claim 19, drawn to a method of making toners,
classified in class 430, subclass 137.17.

5. The inventions are distinct, each from the other because of
the following reasons:

Inventions II and Ia are related as process of making and
product made. The inventions are distinct if either or both of
the following can be shown: (1) that the process as claimed can
be used to make another and materially different product or (2)
that the product as claimed can be made by another and
materially different process (MPEP § 806.05(f)). In the instant
case the toner product can be made by a materially different
process, such as the process in Group III, which requires the
steps of "emulsifying a resin binder," adding "an element" to
the resin binder, and controlling the addition time of the
element, the emulsion polymerization conditions, an aggregation
of the toner particles, or a washing condition after emulsion
polymerization. Furthermore, the toner can also be made by a
process comprising the steps of aggregating resin particles

Art Unit: 1756

obtained by a suspension polymerization method together with particles comprising "an element" to form aggregated particles, heating the aggregated particles to coalesce the aggregated particles, and encapsulating the coalesced particles with a polymeric shell to form core-shell toner particles. Both processes do not require melting a mixture of resin binder and "an element" and crushing the melted mixture as required in the process in Group II.

Inventions III and Ia are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the toner product can be made by another and materially different process, such as the process in Group II, which requires the steps of mixing a binder resin and "an element," melting the mixture, and crushing the melted mixture.

Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of

Art Unit: 1756

operation. As discussed supra, the invention in Group II is drawn to a method of making a toner comprising the steps of mixing a binder resin and "an element," melting the mixture, and crushing the melted mixture. The invention of Group III is drawn to a method of making a toner comprising the steps of "emulsifying a resin binder," adding "an element" to the resin binder, and controlling the addition time of the element, the emulsion polymerization conditions, an aggregation of the toner particles, or a washing condition after emulsion polymerization. The invention in Group II does not require the steps of the invention in Group III. Nor does the invention in Group III require the steps in Group II.

Invention Ib and inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions, different effects, and different modes of operation. The invention in Group Ib is drawn to an image forming method comprising the steps of forming an electrostatic image on the surface of a photoreceptor, developing the electrostatic image with a developer to form a toner image, transferring the toner image to

Art Unit: 1756

a recording medium, and fixing the toner image to the recording medium. The inventions in Groups II and III are drawn to methods of making toners, as described supra. The invention in Group Ib does not require the steps of the inventions in Groups II or III. Nor do the inventions in Groups II or III require the steps in Group Ib.

Because these inventions are also independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and in view of their different classification, restriction for examination purposes as indicated is proper.

6. A telephone call was made to Mr. Daniel P. Lent (Reg. No. 44,867) on Aug. 28, 2006, to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicants are advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election

Art Unit: 1756

must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicants traverse on the ground that the inventions or species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

7. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1756

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1500
1700

JLD

Aug. 28, 2006